



GOBIERNO DE PUERTO RICO
DEPARTAMENTO DE ESTADO



March 28, 2022

Samuel F. Pamias
256 Eleanor Roosevelt
San Juan, PR 00918

SUBJECT MATTER
MARK
CLASS
FILING NUMBER
FILING DATE
APPLICANT

Office Action
PLUM
028
244529-28-0
July 7, 2021
Plum Products Holdings Pty Ltd.

To whom it may concern:

In order to proceed with the examination of the said mark Applicant must submit the following information:

- | | |
|---------------|--|
| <u> x </u> | 1. State clearly the goods or services in connection with the mark as used or intended to be used in commerce in Puerto Rico. This applies if the Applicant customized the selection of goods or services. |
| <u> </u> | 2. Provide a drawing of the mark as used or as intended to be used in commerce in Puerto Rico. |
| <u> </u> | 3. Provide a detailed description of the mark as used or as intended to be used in commerce in Puerto Rico. |
| <u> </u> | 4. Provide a specimen that shows the mark in connection with the goods or services identified in your application. |
| <u> </u> | 5. Applicant must disclaim those terms or components of the mark which are not susceptible of exclusive appropriation. |
| <u> </u> | 6. Others. |
| <u> </u> | 1. The registration for the applied mark is refused on the following grounds: |

OFFICE ACTION

The P.R. Trademark Office (the "PRTO") has reviewed its records and has determined that there are no similar or pending marks that would bar registration of this mark under the P.R. Trademark Act. However, in order to proceed with the examination of the mark, the PRTO requires the Applicant to amend the application as follows:

Description of Goods is Overly Broad:

Rule 20 of the Trademark Registry Procedure Code of the Department of State for The Commonwealth of Puerto Rico (hereinafter, the Rules) provides that applications for registration of trademarks must include a list of the goods or services in relation to which a Trademark registration is desired.

An application of a mark must specify the goods or services on or in connection with which the Applicant uses, the mark in commerce. The identification should set forth common names, using terminology that is generally understood. The identification of goods or services must be specific, definite, clear, accurate, and concise. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), reversed on other grounds, 824 F.2d 957 (Fed. Cir. 1987); *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), modified without opinion, 498 F.2d 1406 (C.C.P.A. 1974); *In re Cardinal Laboratories, Inc.*, 149 USPQ 709 (TTAB 1966); *California Spray-Chemical Corp. v. Osmose Wood Preserving Co. of America, Inc.*, 102 USPQ 321 (Comm'r Pats. 1954); *Ex parte A.C. Gilbert Co.*, 99 USPQ 344 (Comm'r Pats. 1953).

The wording: "Games; gymnastic and sporting articles not included in other classes; decorations for Christmas trees; toys; outdoor play equipment; outdoor activity toys; playground equipment; climbing frames; dome-shaped climbing frames; toy houses; play castles; play tents; play tree houses; outdoor play sets; swings; see-saws; slides; gaming tables; play swimming pools; sandboxes for children; water toys; table tennis tables; pool tables; snooker tables; air hockey tables; pucks and mallets for air hockey; football tables; basketball goals; bouncy castles; play kitchens; role playing toys; indoor play sets; dolls; dolls' clothing; dolls' houses; dolls' house furniture; game consoles; toy vehicles; toy garages; ride-on toys; trampolines; play mats; trampoline protective pads; fitted covers for trampolines; sand box toys; water tables; tables for playing games; table tennis bats and balls; petanca sets; playing balls; bat and ball sets; baseball sets; cricket sets; tennis sets; badminton sets; soccer goals; ring games; croquet sets; dominoes; bowling games; scooters [toys]; push-toys; play easels; play drawing screens; bouncers for children; air-inflatable bouncers for children; climbing nets; play rope ladders; play water slides; race tracks; parts, fittings and accessories for any of the aforesaid goods." under International Class 028, contains language that isn't specific enough therefore, resulting in a broad description of the products.

The Registry has discretion to require the degree of specificity necessary to identify the goods or services in relation to which the mark is used in the commerce of Puerto Rico.

The applicant may adopt the following recitation of goods, if accurate:

Class 028

Tabletop Games; gymnastic and sporting articles not included in other classes, namely, {list specific goods by common commercial or generic name, e.g., gymnastic apparatus, balls for sports, baseball bats, baseball gloves, footballs, basketballs, shin guards and wrist guards for athletic use}; Christmas tree decorations for Christmas trees; {Please specify e.g. pet, infant} toys; Kits for building outdoor play equipment; outdoor activity toys, namely, _____ {indicate goods, e.g., baseball bats, soccer balls}; playground equipment, namely, {specify item, e.g., climbing units, sand boxes, swing sets}; playground equipment, namely, climbing frames; playground equipment, namely, dome-shaped climbing frames; toy houses; play houses, namely, play castles; play tents; play tree houses; playground equipment, namely, outdoor play sets; swings; see-saws; playground slides; gaming tables [for gambling]; play swimming pools; playground equipment, namely, sandboxes for children; water toys; table tennis tables; pool tables; snooker tables; air hockey tables; pucks and mallets for tabletop hockey games; tabletop games, namely, tabletop football tables; gymnastic and sporting articles, namely, basketball goals; inflatable toys, namely, inflatable structures with windows shaped like

castles in which children can safely jump around and play; play kitchens; role playing toys in the nature of play sets for children to imitate real life occupations; Indoor play apparatus for children, namely, play mats and play houses ~~indoor play sets~~; dolls; dolls' clothes ~~clothing~~; dolls' houses; furniture for dolls' houses ~~furniture~~; video game consoles; toy vehicles; **toys**, namely, toy garages; ride-on toys; trampolines; play mats **containing infant toys**; trampoline protective pads; fitted covers for trampolines; **playground** sand box ~~toys~~; water tables **being** _____ {clarify nature of goods, e.g., **playground water toys**}; tables for playing games, namely, _____ {specify type of games, e.g., **table tennis, card games**}; table tennis bats and balls; **outdoor games**, namely, **petanque set**; playing balls; **baseball bat and ball sets**; baseball sets **comprising bats and balls**; **sporting articles**, namely, cricket sets **including cricket bats and cricket balls**; **garden toys**, namely, tennis sets **comprised of** _____ [specify the major components, e.g., **tennis racquets, tennis balls, etc.**]; badminton sets; soccer goals; ring games; croquet sets; dominoes; **Arcade** bowling games **machines** ; **toy** scooters ~~{toys}~~; push-toys; play easels; **cleanable children's painting screens** ~~play drawing screens~~; bouncers for children in the nature of _____ {clarify nature of goods, e.g., **trampoline bounce boards**}; air-inflatable bouncers for children in the nature of _____ {clarify nature of goods, e.g., **toy balls for bouncing**}; **toy** climbing nets; play rope ladders; play water **cascade toys slides**; **toy vehicle tracks**, namely, race tracks; ~~parts, fittings and accessories for any of the aforesaid goods.~~

* Note that these suggestions are illustrative and not exhaustive.

Applicant is advised to examine the International Classification of Goods and Services established under the Nice Agreement, Tenth Edition, to describe the products or services that are used commercially in Puerto Rico. See <http://www.wipo.int/classifications/nice/es/>.

Note that Rule 33 of the Rules provides that the applicant may amend his application during the review of the application, when required by the Examining Attorney or other official reasons. The applicant may amend his application to clarify or limit, but not to extend the identification of goods or services. Given the above, the Examining Attorney requires that the applicant modify and amend its application for renewal as indicated in this Office Action or otherwise show cause why this amendment is not necessary.

In light of the aforementioned, the Examiner requires the Applicant to modify and/or amend the application for registration as provided herein or, otherwise, show cause why such modification is not required.

According to Rule 36 of Puerto Rico's Trademark Rules of Procedure amendments filed must be specified in a written and signed statement by the Applicant or its Representative. Neither Applicant nor its Representative shall rewrite, alter, modify, erase or include words in a pending application. However, the Puerto Rico Trademark Office (PRTO) may amend the said application with the Applicant's consent.

According to Rule 27 of Puerto Rico's Trademark Rules of Procedure, if the PRTO does not receive a response to the abovementioned remarks within ninety (90) days, the Application shall be considered abandoned.

Note: Please refer to the name of the Examining Attorney. The office action response shall be filed online at <https://prtmfiling.f1hst.com/> using the transaction office action response. The cost for the said filing is \$15.00. If you have any questions via email to jpagan@estado.pr.gov

Cordially,



Julio J. Pagán Pérez
Examining Attorney
Puerto Rico Trademark Office